IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant :	Anthony Nicholls	Art Unit	:	1631
Serial No. :	09/644,937	Examiner	:	John S. Brusca
Patent No. :	**7,110,888** (projected)			
Issue Date :	September 19, 2006 (projected)			
Filed :	August 23, 2000	Confirmation no.	:	1945
Title :	METHOD FOR DETERMINING A SHAPE SPACE FOR A SET OF MOLECULES USING MINIMAL METRIC DISTANCES			

Mail Stop Petition
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

REQUEST FOR RECONSIDERATION OF *DECISION* ON PATENT TERM ADJUSTMENT UNDER 37 C.F.R. § 1.705(b)

AND

REQUEST FOR RECONSIDERATION OF PATENT TERM ADJUSTMENT UNDER 37 C.F.R. § 1.705(d)

Sir:

Applicant hereby requests reconsideration of the Office's Decision on Applicant's Request for Reconsideration of Patent Term Adjustment under 37 C.F.R. § 1.705(b), mailed July 26, 2006 ("Decision"), in the above-identified U.S. Patent Application.

Applicant also, additionally, and independently of any ultimate determination of patent term adjustment under 37 C.F.R. § 1.705(b), requests reconsideration under 37 C.F.R. § 1.705(d) of the Patent Term Adjustment of 189 days specified on the Issue Notification, mailed August 30, 2006, in connection with the above-identified U.S. Patent Application.

Applicant makes the instant requests synchronously, and in the same paper, to facilitate review by the Petitions Officer.

The Request for Reconsideration of the Decision under 37 C.F.R. § 1.705(b)

Under § 1.705(b), Applicant may request reconsideration of Patent Term Adjustment (PTA) on or before payment of the issue fee, if Applicant believes that the amount of PTA indicated on form PTOL-85 ("Determination of Patent Term Adjustment under 35 U.S.C. § 154(b)") accompanying the Notice of Allowance is in error. Applicant timely made such a request, on February 1, 2006. In the Decision mailed July 26, 2006, the U.S. Patent and Trademark Office (the "Office") granted Applicant's request in part.

Applicant now requests further reconsideration of the Office's Decision to the extent that it denied Applicant's original request. The instant request is believed timely because it addresses matters up to and including the mailing date of a corrected Notice of Allowance and because it is being filed before the Issue Date of the above-identified patent.

Applicant thanks Petitions Examiner, Cliff Congo, for courtesies extended to the undersigned during a telephone conversation on September 18, 2006, to discuss the Decision. As discussed by telephone, Applicant now requests reconsideration of the following:

1. The delay attributed to Applicant in connection with the response filed March 10, 2003; and
2. The delay between the mailing of the first Notice of Allowance (September 14, 2005) and the corrected Notice of Allowance (November 4, 2005).

In the interests of brevity, Applicant only recounts those facts in connection with the file history that are germane to the instant request for reconsideration.

(1) Applicant's Response to Non-final Action mailed September 10, 2002 was filed on March 10, 2003 ("The March 10, 2003 Response"). The Office has determined, and Applicant agrees that, the delay attributable to Applicant is 90 days. The Office subsequently mailed a Notice of Informal or Non-Responsive Amendment on June 30, 2003 ("The June 30, 2003 Notice") in which the Office designated Applicant's March 10, 2003 Response to be "non-responsive" for allegedly failing to provide a Substitute Abstract *on a separate sheet*. On the basis of this alleged omission, the Office has attributed a further 132 days of delay to Applicant.

Applicant responded to the June 2003 Notice by supplying a Substitute Abstract on a separate sheet, on July 21, 2003. The Office did not issue a further action until May 19, 2004.

Applicant now respectfully requests reconsideration of the Office's decision to attribute 132 days of delay to Applicant because the record clearly evidences Applicant's intent to advance prosecution, and not to unreasonably delay it, and also because the non-responsiveness alleged by the Office is in no way connected with the Office's own ability to carry out examination of the application, and in fact inured to Applicant's considerable disadvantage.

In short, Applicant respectfully requests the Office to reconsider why a supposed omission of a substitute abstract *on a separate sheet where the abstract has also been presented in marked-up form*, "constitutes a failure of Applicant to engage in reasonable efforts to conclude processing or examination of an application" (as set forth in 37 C.F.R. § 1.704(c)(7)).

If it is assumed that the Abstract was in fact not supplied by Applicant on a separate sheet,[1] Applicant disagrees that such an omission warrants attributing an additional delay of 132 days to Applicant. Applicant notes that the March 10, 2003 Response had supplied a Substitute Abstract, though not on a separate sheet of paper. The June 30, 2003 Notice acknowledges that Applicant's March 10, 2003 Response was "*bona fide*." In short, the information necessary for the Examiner to examine Applicant's March 10, 2003 Response was before the Examiner at that time. To penalize Applicant for what is no more than a ministerial error, and one which has no substantive effect on the advance of the Application on the merits, is, respectfully, wholly unreasonable. In fact, by requesting compliance with a matter of formality, rather than substance, the Office itself unnecessarily delayed examination of Applicant's application, to detriment of Applicant by a further 9 months (to May 2004).

Applicant also respectfully points out Applicant's swift compliance with the June 30, 2003 Notice, to which Applicant filed a response on July 21, 2003, be considered further evidence of Applicant's earnest efforts to advance prosecution of the Application.

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[1] Applicant's March 10, 2003 Response references an attached Substitute Abstract on a separate sheet (item (c) on page 1), thereby evidencing a clear intent to comply with the Examiner's request. It is unclear from the record that the attached Substitute Abstract was not supplied by Applicant on a separate sheet, as alleged by the PTO. It remains not inconsistent with the record that the separate sheet was lost by the PTO upon receipt.

Accordingly, Applicant disagrees with the Office's attribution of 132 days of delay to Applicant, and respectfully requests at least that such delay not be subtracted from Applicant's Patent Term Adjustment.

Finally, Applicant respectfully points out that it has been to Applicant's disadvantage that, after receipt of the Substitute Abstract on July 21, 2003, the Office took a further 9 months to next act on the case. This period of time is far in excess of anything that could be reasonably connected with alleged non-responsiveness of Applicant's March 10, 2003 response.

Accordingly, and in the alternative, Applicant respectfully requests that the 4-month period within which the Office must issue an action be measured not from July 21, 2003, but from March 10, 2003, which is when Applicant filed a response that could have been examined by the Office. By such a calculation, the delay attributable to the Office is 314 days (from July 10, 2003 to May 19, 2004).

(2) An Office Action was due July 17, 2005, four months from Applicant's response to non-final action on March 17, 2005. The Office mailed a Notice of Allowance on September 14, 2005, and an Office delay of 59 days was accorded. Applicant agrees that at least 59 days are attributable to the Office in this regard. Upon review of the Notice of Allowance mailed September 14, 2005, Applicant noticed that claims 23-26 had been improperly cancelled by the Examiner. Accordingly, Applicant's undersigned representative discussed this matter with Examiner John S. Brusca by telephone, on October 12, 2005, less than 30 days after the mailing of the Notice of Allowance, and requested reinstatement of the claims.

The Examiner issued a *Corrected* Notice of Allowance and accompanying Examiner's amendment that reinstated the improperly cancelled claims on November 4, 2005. The Corrected Notice of Allowance also contained a new mail date, re-starting the period of time for payment of issue fee. The diffcrence between the Office's mailing of the Notice of Allowance of September 14, 2005 and the Office's mailing of the Corrected Notice of Allowance of November 4, 2005 is 51 days. Since the requirement for a corrected notice of allowance was due to PTO error, the total PTO delay for the mailing of a Notice of Allowance should total 110 days (*i.e.*, 59 + 51 days) rather than 59 days.

In the Decision, the Office states that, since the Corrected Notice of Allowance did not "vacate" the first Notice of Allowance, no additional delay is attributable to the Office. During a

telephone conversation held this day with petitions attorney Congo, the justification offered was that Applicant's payment of Issue Fee came almost three months after the mailing date of the Corrected Notice of Allowance, and not within three months of the mailing date of the original Notice of Allowance thus allegedly evidencing undue delay on the part of the Applicant.

Applicant respectfully disagrees. Although the Corrected Notice of Allowance did not formally "vacate" the original Notice of Allowance, it set a new date for response, which is equivalent to removing any formal requirements associated with the original Notice of Allowance. Therefore, since the need to issue a Corrected Notice of Allowance arose from an Office error, Applicant should not be penalized for the attendant delay between issuing the two notices of allowance, and such delay should be attributed to the Office. Furthermore, Applicant knows of no principle, according to which, responding within, but towards the end of a period of time set by the Office, is judged evidence of Applicant's delay. Indeed the Patent Term Adjustment statutes and implementing rules make it clear that delay is attributed to an Applicant when extensions of time for response are sought not when the full (unextended) time available is utilized. In the instant situation, Applicant's issue fee payment was timely made within the time limit set by the Corrected Notice of Allowance. Nothing more was required of Applicant.

Summary

In consideration of the foregoing, Applicant respectfully requests that the PTA under 37 C.F.R. § 1.705(b) be recalculated as follows:

- PTO Delay be increased by 51 days; and
- Applicant's delay be decreased by 132 days, *or* the Office's delay be increased by 314 days.

The Request for Reconsideration of Patent Term Adjustment under 37 C.F.R. § 1.705(d)

The Form PTOL-85 mailed with the Corrected Notice of Allowance November 4, 2005, stated that the Patent Term Adjustment (PTA) would be 194 days. Applicants timely paid the issue fee, February 1, 2006. The Issue Notification, mailed August 30, 2006, indicates that the Patent Term Adjustment is only 189 days. Applicants filed no other paper after receipt of the Notice of Allowance that falls into any of the categories of 37 C.F.R. § 1.704(c)(10).

Applicant has checked the file history of the instant application and has also reviewed the "Patent Term Adjustment History" on the Patent Application Information and Retrieval (PAIR) section of the Office's web-site. A 120-day delay was attributed to Applicant as a result of a "miscellaneous incoming letter", mailed December 2, 2005.

The "miscellaneous incoming letter" is Applicant's Statement of Substance of Interview. This statement was requested by the Office, as set forth in the Examiner's Interview Summary, mailed November 4, 2005, setting a time for response of 30 days for filing Applicant's statement. Applicants point out that the Interview Summary was generated by the Office when Applicant contacted the Examiner to discuss the Office's improper cancellation of certain claims in the Examiner's Amendment that accompanied the original Notice of Allowance, mailed September 14, 2005. Accordingly, the need for an interview after allowance was as a result of Office error; the request for an Applicant's statement regarding the interview was made by the Office, and Applicant's December 2, 2005 filing of such a statement was in timely compliance with the same.

Furthermore, an Applicant's Statement of Substance of Interview is *not* in the category of items that "**will be** considered a failure to engage in reasonable efforts to conclude processing", as set forth in MPEP § 2732 (emphasis included)

Accordingly, Applicant sees no grounds for attributing 120 days of delay to Applicant, and hereby respectfully requests reconsideration thereof, and reinstatement of 120 days to the total Patent Term Adjustment.

Applicant submits this request for reconsideration under 37 C.F.R. § 1.704(d) within 60 days of the issue date of the above-identified U.S. Patent.

Applicant reserves the right to request further reconsideration of patent term adjustment calculated under 37 C.F.R. § 1.704(d) and not considered herein, within 60 days of issue of the above-identified patent.

Concluding Remarks

Applicant respectfully requests correction of the PTA, under the provisions of 37 C.F.R. § 1.705, to 511 days.

Applicant asserts, as required by 37 C.F.R. § 1.705(b)(2)(iii), that the subject U.S. patent application is not subject to a terminal disclaimer.

Applicant further asserts, as required by 37 C.F.R. § 1.705(b)(2)(iv)(B), that they did not fail to engage in reasonable efforts to conclude processing and examination of the application, except where delays attributable to Applicant are acknowledged herein.

Fee Authorization

Applicant believes that the error in calculation of patent term adjustment was a result of Office error, and, therefore, that no fee should be levied in respect of the instant request.

Nevertheless, should it be determined that such a fee is owed, and in compliance with 37 C.F.R. § 1.705(b)(1), Applicant hereby authorizes payment of the fee of $200.00, under 37 C.F.R. § 1.18(e) from deposit account number 06-1050 (order no. 19455-002001). A copy of this sheet is enclosed for such purpose.

The Commissioner is further hereby authorized to charge any deficiency or credit any overpayment to deposit account no. 06-1050 (order no. 19455-002001).

Respectfully submitted,

Date: September 18, 2006

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